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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,999	09/30/2003	Jessica L. Voss-Kehl	58227US002	5245
32692	7590	06/15/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			PENG, KUO LIANG	
			ART UNIT	PAPER NUMBER
			1712	
DATE MAILED: 06/15/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,999

Applicant(s)

VOSS-KEHL ET AL.

Examiner

Kuo-Liang Peng

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/30/06 Amendment.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 8-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Applicants' amendment filed on March 30, 2006 is acknowledged.

Claims 6-7 and 27-59 are deleted. Claims 18, 21 and 25 are amended. Now,

Claims 1-5 and 8-26 are pending.

2. Claim rejection(s) under 35 USC 112 in the previous Office Action (Paper No. 122405) is/are moot.

3. Claim rejection(s) under 35 USC 102 in the previous Office Action (Paper No. 122405) is/are moot.

4. Claim rejection(s) under 35 USC 103 in paragraph 10 of the previous Office Action (Paper No. 122405) is/are moot.

5. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

Claim Rejections - 35 USC § 112

6. Claims 18 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 18 (line 2), “or less” causes confusion because it does not exclude the amount of “0”, and Claim 16 requires the presence of the additive.

In Claim 25 (line 2), “or less” causes confusion because it does not exclude the amount of “0”, and Claim 23 requires the presence of the additive.

Claim Rejections - 35 USC § 103

7. Rejection of Claims 1-5, 9-19, 22 and 26 under 35 USC 103(a) as being unpatentable over Matsuda (US 6 586 104) in view of Iryo (US 5 789 476) is maintained because the rejection is adequately set forth in paragraph 6 of Paper No. 122405. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 7, 5th to 7th paragraphs and bridging to page 8, 1st paragraph), it is noted that the viscosity feature of the present invention has been addressed in Paper No. 072005. Furthermore, noted that

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“using in a digital printing technique” is merely an intended use, and does not carry any weight of patentability. As mentioned in Paper No. 072005 (page 2), Matsuda’s polymer has a molecular weight range (col. 5, lines 50-60) **substantially overlap** with that of Applicants’ polymer (Specification, page 16, last paragraph). Furthermore, Matsuda’s solid content of the composition can **preferably** be as low as 7% up to as high as 60% depending on the **application method and coating thickness**. (col. 6, lines 19-25) Therefore, Examiner has a reasonable basis to believe that within this range of solid content, Matsuda’s composition should possess a suitable viscosity for the intended specific application set forth in the instant claims, absent evidence to the contrary. Especially, Matsuda’s solid content reads on the solid contents of **Applicants’ examples**. If Matsuda’s viscosity of the composition with preferred solid content is not exactly what suitable for the intended application set forth in the present invention, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to adjust the composition with not so preferred solid content through routine experimentation in order to obtain a composition with a desired viscosity for certain application methods or coating thicknesses. Applicants are advised that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different

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problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) In addition, arguing that Applicants' composition showing little tendency towards thixotropy is not persuasive because prima facie obviousness is not rebutted by merely recognizing additional advantages or latent properties present in the prior art. See MPEP 2145 II.

8. Rejection of Claims 20-21 under 35 USC 103(a) as being unpatentable over Matsuda in view of Chandross (US 6 251 486) is maintained because the rejection is adequately set forth in paragraph 7 of Paper No. 122405. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 8, 4th paragraph), Examiner's position, *supra*, is applicable here.

9. Rejection of Claims 1-5, 8, 10-15, 18-19, and 22-26 under 35 USC 103(a) as being unpatentable over Matsuda in view of Atkinson (US 4 909 852) is maintained because the rejection is adequately set forth in paragraph 8 of Paper No. 122405. Applicant's arguments have been fully considered but they are not

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persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 8, 6th paragraph), Examiner's position, *supra*, is applicable here.

10. Rejection of Claims 16-18 (when the specific additive in Claim 18 is present) under 35 USC 103(a) as being unpatentable over Matsuda in view of Rotenberg (US 4 173 490) is maintained because the rejection is adequately set forth in paragraph 9 of Paper No. 122405. Applicant's arguments have been fully considered but they are not persuasive. The focus argument related to the core patentability is discussed below.

For Applicants' argument (Remarks, page 8, last paragraph bridging to page 9, 1st paragraph), Examiner's position, *supra*, is applicable here.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the

end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

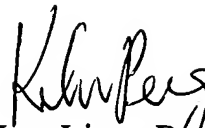
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on

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access to the Private PAIR system, contact the Electronic Business Center (EBC)
at 866-217-9197 (toll-free).

klp

June 9, 2006



Kuo-Liang Peng
Primary Examiner
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